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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,078	02/05/2002	Daniel M. Judge	13808-002001	7452

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EXAMINER

HOOLAHAN, AMANDA J

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/068,078

Applicant(s)

JUDGE, DANIEL M.

Examiner

Amanda J Hoolahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5-8 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 5-8, 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 3 and 5-7 are finally rejected under 35 U.S.C. 102(n) as being unpatentable by USPN 4,195,787 to Thomason.

Thomason discloses a rolled product of continuous separable sheets, comprising at least a first (A) and second (B) contiguous separable sheet of product wound around an axis (C), forming a cylindrical roll, each sheet having an outer edge positioned parallel to the axis; at least the first and second contiguous separable sheet (A, B) of product (11) having at least one indicium (14) that bears a predetermined relationship when the first sheet is the outer most sheet of the rolled product (11), such that a discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which lies directly beneath the outer edge of each sheet having the indicium when the sheets are formed into a cylindrical roll, wherein the indicium is a continuous undulating indicium (14', see Figure 4) (column 1, lines 22-23); at least the first and second sheet of contiguous separable sheets (A, B) of product (11) have a plurality of indicium (14, D); the plurality of indicium are out-of-phase from each other; the continuous undulating indicium are sinusoid-shaped (See Figure 4) having a predetermined wavelength.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 8 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason.

Thomason discloses the rolled product as described above in paragraph 2 including the sheets being of length L.

Thomason does not disclose the particular value of the wavelength of each of the sinusoid-shaped indicium being substantially equal to L.

With respect to the particular value of the wavelength of each of the sinusoid-shaped indicia being substantially equal to L: To make the wavelength of each of the sinusoid-shaped indicia being substantially equal to L, this is only considered to be the “optimum” value of the wavelength of each sinusoid-shaped indicium disclosed by Thomason, as stated above, that a person having ordinary skill in the art at the time the invention was made would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the wavelength of each of the sinusoid-shaped indicia being substantially equal to L in order to save on manufacturing costs by imprinting a lesser amount of sinusoidal-shaped indicia on the rolled product.

5. Claims 15-18, 20-21, and 23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason in view of USPN 6,282,807 to Johnson.

Thomason discloses the rolled product as described above in paragraph 2 wherein normal manufacture of the device comprises the method steps of making a roll of contiguous separable sheets of product with a mark for visually locating the end of the roll comprising marking the sheets with at least one visually perceivable mark extending the length of each of the sheets, the visually perceivable mark bearing a predetermined relationship between the portion of the mark at the edge of each sheet and the portion of the mark that lies directly beneath each edge when the sheets are spooled onto a roll, such that a discontinuity is likely formed between the mark at any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located and spooling the sheets into a cylindrical roll; marking the sheets with a plurality of marks; the plurality of marks are each sinusoid-shaped; each of the sinusoid-shaped marks are out of phase from one another; the sheets being toilet paper (column 1, line 15); the sheets are paper toweling (column 1, line 9); the mark is printed on the sheets.

Thomason does not disclose the perceivable mark being continuous for the entire length of the said roll.

Johnson discloses a rolled product that has a perceivable mark that is continuous for the entire length of said roll. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the perceivable mark, as taught by Thomason, to be continuous for the entire length of the roll, as taught by Johnson, in order for

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the device to be simpler to manufacture since it would only require the marking device to stay in one place, rather than restart the marking process every four sheets.

6. Claims 19 and 22 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason.

Thomason discloses the rolled product as described above in paragraph 2 including the sheets being of length L.

Thomason does not disclose the particular value of the wavelength of each of the sinusoid-shaped indicium being substantially equal to L.

With respect to the particular value of the wavelength of each of the sinusoid-shaped indicia being substantially equal to L: To make the wavelength of each of the sinusoid-shaped indicia being substantially equal to L, this is only considered to be the “optimum” value of the wavelength of each sinusoid-shaped indicium disclosed by Thomason, as stated above, that a person having ordinary skill in the art at the time the invention was made would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the wavelength of each of the sinusoid-shaped indicia being substantially equal to L in order to save on manufacturing costs by imprinting a lesser amount of sinusoidal-shaped indicia on the rolled product.

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7. Claim 25 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason in view of USPN 4,076,121 to Clayton et al. [hereinafter Clayton].

Thomason discloses a rolled product of contiguous separable sheets as described above in paragraph 2.

Thomason does not disclose the sheets being plastic bags.

Clayton discloses a rolled product being separable sheets of plastic bags. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the indicia disclosed by Thomason with a rolled product comprised of separable sheets of plastic bags, as taught by Clayton, in order to determine the free end of the rolled product and since Thomason already suggests that the indicia could be used with products manufactured in a rolled form (Column 1, lines 1-10).

8. Claim 27 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason in view of USPN 6,221,211 to Hollenberg et al. [hereinafter Hollenberg].

Thomason discloses a rolled product of contiguous separable sheets as described above in paragraph 2.

Thomason does not disclose the mark being dyed on the sheets.

Hollenberg discloses a tissue product having a mark that is dyed on the sheets (17). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the indicia dyed on the sheets, as taught by Hollenberg, instead of imprinted, as taught by Thomason, since the way that the indicia is added to the rolled product, absent of any criticality, is considered to be nothing more than a choice of engineering skill,

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choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the indicia is added to the rolled product as already suggested by Thomason, and 2) the use of the particular way of adding the indicia claimed by Applicant, is considered to be nothing more than the use of one of numerous and well known alternate types of markings that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to permanently add the indicia on the rolled product.

9. Claim 28 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason in view of USPN 5,266,257 to Kildune.

Thomason discloses a rolled product of contiguous separable sheets as described above in paragraph 2.

Thomason does not disclose the indicia being embossed on the sheets.

Kildune discloses a rolled product having indicia (12) embossed onto the product.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the indicia embossed on the sheets, as taught by Kildune, instead of imprinted, as taught by Thomason, since the way that the indicia is added to the rolled product, absent of any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the indicia is added to the rolled product as already suggested by Thomason, and 2) the use of the particular way of adding the indicia claimed by Applicant, is considered to be nothing more than

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the use of one of numerous and well known alternate types of markings that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to permanently add the indicia on the rolled product.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda J Hoolahan whose telephone number is (703) 308-0139. The examiner can normally be reached on Monday through Friday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.



ajh
August 1, 2003

Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

